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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,692	09/26/2003	Satoshi Hiratsuka	YAMA-0059	9284
37013 7590 03/16/2011 Rossi, Kimms & McDowell LLP 20609 Gordon Park Square Suite 150 Ashburn, VA 20147			EXAMINER WILLIAMS, JEFFERY L.	
			ART UNIT 2437	PAPER NUMBER
			NOTIFICATION DATE 03/16/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mail@rkmllp.com

### Office Action Summary

**Application No.**

10/672,692

**Applicant(s)**

HIRATSUKA, SATOSHI

**Examiner**

JEFFERY WILLIAMS

**Art Unit**

2437

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-6,8,9 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,8,9 and 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

This action is in response to the communication filed on 12/17/10.  
All objections and rejections not set forth below have been withdrawn.  
Claims 1, 4 – 6, 8, 9, and 11 – 15 are pending.

***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The specification fails to provide proper antecedent basis for the recitations of a server comprising coded instructions to “*at least (a) supply, via downloading, the contents to each of the information processing terminals associated with the user*” [claim 9] and a server controlling section that “*at least (a) supplies, via downloading, the contents to each of the information processing terminals associated with the user*” [claim 1].

Applicant states that the originally filed specification (e.g. par. 39, 40) discloses that “*the same contents requested by the user are downloaded from the server (e.g., SV) to a plurality of terminals (e.g., PCa1, PCa2) associated with the user*”.

However, the examiner respectfully notes that this statement and the corresponding claim recitations are unsupported and inaccurate.

Specifically, the applicant's disclosure reveals that a user may access a server request/purchase content – of which the user is able to individually download said requested/purchased content into one or more of his/her devices (e.g. refer to par. 39, 40). Thus, the specification merely supports the previously recited notion that "*contents ... being downloadable to each information processing terminal*" (e.g. see claim 1, 9). Or, in other words, the specification only supports the idea that content is capable of being downloaded into a user's devices.

However, such a disclosed feature does not state or suggest the claimed notion that any content which is requested/purchased by a user would be downloaded, by the server, into all of the devices owned by a user (i.e. "*at least (a) supplies, via downloading, the contents to each of the information processing terminals associated with the user*").

### ***Claim Rejections - 35 USC § 112***

#### **The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1, 4, 5, 9, 11 - 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

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1 application was filed, had possession of the claimed invention. Applicant has not shown  
2 how the amended claim is supported, nor does there appear to be a written description  
3 of the claim limitations in the application as filed (see above objection to the  
4 specification).

6 **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

7 The specification shall conclude with one or more claims particularly pointing out and distinctly  
8 claiming the subject matter which the applicant regards as his invention.

9  
10 **Claims 1, 4, 5, 9, 11 – 15 are rejected under 35 U.S.C. 112, second**  
11 **paragraph, as being indefinite for failing to particularly point out and distinctly**  
12 **claim the subject matter which applicant regards as the invention.**

13 Regarding claims 1 and 9, applicant alleges that the recitations of a server  
14 comprising coded instructions to "*at least (a) supply, via downloading, the contents to*  
15 *each of the information processing terminals associated with the user*" [claim 9] and a  
16 server controlling section that "*at least (a) supplies, via downloading, the contents to*  
17 *each of the information processing terminals associated with the user*" [claim 1] signify  
18 that "*the same contents requested by the user are downloaded from the server (e.g.,*  
19 *SV) to a plurality of terminals (e.g., PCa1, PCa2) associated with the user*". However,  
20 the applicant's specification, cited by the applicant as the alleged support (e.g. par. 39,  
21 40) only reveals the obvious fact that content is downloadable (as is previously recited,  
22 i.e. "*contents ... being downloadable to each information processing terminal*", see  
23 claim 1, 9) and that a user may access a server request/purchase content, such that the

user is able to individually download said requested/purchased content into one or more of his/her devices (e.g. refer to par. 39, 40).

Thus, the examiner notes that the applicant's recitations appear ambiguous, as they do not appear in harmony with the actual disclosure of the applicant. For the purpose of examination, and in harmony with paragraphs 39 and 40, for which the applicant admits as the basis for interpretation, the examiner presumes such recitations to signify that requested or purchased content is capable of being individually downloaded by the user into the devices owned by a user.

Depending claims are rejected by virtue of dependency.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 4 – 6, 8, 9, and 11 – 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Nozaki et al., (Nozaki), US Patent Publication 2002/0036800 A1.**

Regarding claim 1, Nozaki discloses:

1           *A contents supplying server apparatus that supplies contents for downloading via*  
2   *a communication network (fig. 2:1; see also figs. 12 -14, par. 220-221);*

3           *and a plurality of information processing terminals associated with a user,*  
4   *contents from the contents supplying server apparatus being downloadable to each*  
5   *information processing terminal from the contents supplying server apparatus via a*  
6   *communication network (fig. 2:2a, 2b, 3, 5, 6; par. 13,14, 40, 48 – herein the Nozaki*  
7   *discloses the prior art feature of a user possessing a plurality of “information processing*  
8   *terminals”, wherein the “information processing terminals” [e.g. fig. 2: 2a, 2b] are each*  
9   *connected to “a communication network” and may be used to download “contents” from*  
10   *a “contents supplying server apparatus”),*

11           *wherein the contents supplying server apparatus comprises: a server storing*  
12   *device for storing, together with numerous contents, user information for the user,*  
13   *including user ID information representing a plurality of information processing terminals*  
14   *associated with the user and contents purchase information comprising contents ID*  
15   *information and copy control data, wherein the copy control data includes a total*  
16   *number of times the downloaded contents are allowed to be copied to an external*  
17   *apparatus or recording medium (fig. 3:8, see also fig. 13,14, par. 220,221 - herein*  
18   *Nozaki discloses a server storing device; par. 113, 190, 212-215, see also, par.*  
19   *63,73,80 – herein Nozaki discloses that the server apparatus is provided with copy*  
20   *control data indicating the maximum allowed copies as dictated by a copyright holder);*

21           *and a server controlling section that at least (a) supplied, via downloading, the*  
22   *contents to each of the information processing terminals associated with the user, and*

(b), in response to a copy permission request from the user via one of the information processing terminals: supplies the copy control data of the user to the one information processing terminal (par. 62, 63, 105-107, 113, 146, 147 – it is herein noted that Nozaki discloses that one of the information processing terminals receives the copy control data), and decrements the total number of times the downloaded contents are allowed to be copied from any of the information processing terminals associated with the user (par. 62, 63, 105-107, 113, 207, 212 – 213 – herein Nozaki discloses that the server's copy control data is amended until it reaches zero, at which point the server must re-order),

wherein each of the information processing terminals comprises: a terminal storing device for storing the downloaded contents from the contents supplying server apparatus (fig. 4:21);

and a sending section for sending to the contents supplying server apparatus a copy permission request (par. 77; fig. 4:36, 28) for copying the downloaded contents to the external apparatus or recording medium each time before the downloaded contents are to be copied to the external apparatus or recording medium (par. 100, 113, 141; fig. 1). Herein, the examiner notes that the prior art anticipates the recited structure of a "sending section" of the claimed apparatus. However, for the applicant's benefit, the examiner notes that Nozaki anticipates such intended use recitation. Regarding the applicant's description of an intended use for the "sending section", the examiner notes that Nozaki discloses a "sending section" that can be used to make a "copy permission" request each time a copy is to be made. Note, that Nozaki allows copyright holders or

distribution servers to limit the copy count at their discretion, such that a user would be required to request a reuse information key before making a copy (par. 100, 113, 141; fig. 1; see also par. 146).

Regarding claim 4, Nozaki discloses:

*wherein said server storing device stores an initial value of the copy control data, contents by contents (par. 63).*

Regarding claim 5, Nozaki discloses:

*wherein said contents are music data (par. 28).*

Regarding claims 6, 8, 9, 13, and 15 they are program and apparatus claims corresponding to claims 1, 4, and 5, and they are rejected, at least, for the same reasons. Furthermore regarding claims 6 and 15, Nozaki discloses:

*a receiving section for receiving the copy control data of the downloaded contents to be copied to the external apparatus or recording medium from the contents supplying server apparatus (par. 78; fig. 4:30, 28);*

*and a terminal controlling section for determining whether or not to copy the downloaded contents to the external apparatus or recording medium based on the received copy control data (fig. 4:35; par. 76).*

Regarding claims 12 and 13, they recite wherein the external apparatus is an electronic musical instrument, however, the examiner notes that "the external apparatus" is not a required limitation of the claims. Therefore, though Nozaki discloses an apparatus capable of reproducing musical notes or sounds (par. 44), it is not necessary to address this recitation.

The examiner respectfully suggests that the applicant explicitly limit the apparatus of claim 1 and the system of claim 6 as comprising the recited electronic musical instrument.

Regarding claim 14, the examiner notes that Nozaki discloses an apparatus capable of reproducing musical notes or sounds (par. 44).

### ***Response to Arguments***

Applicant's arguments filed 12/17/10 have been fully considered but they are not persuasive.

*Applicant argues essentially that:*

First, as to the examiner's allegation that the last reply fails to comply with Rule 11 I(b), 11 (c), applicant submits that the previous arguments set forth in the last reply, namely that (1) the examiner failed to establish how Nozaki anticipates the claims, and (2) the examiner failed (Remarks, pg. 7) to explain how Nozaki's passages relied upon

1 by the examiner discloses (a) the claimed permission-request sending feature and (b)  
2 the server changing the count information or keeping track of copy count information or  
3 the PC sending the count information to the server each time the already downloaded  
4 music contents is copied to an external apparatus or recording medium, fully comply  
5 with Rules 11 I(b) and 111 (c).

6 Second, applicant incorporates the previous arguments set forth in the last reply,  
7 and submits that Nozaki would not have anticipated or taught at least claimed features  
8 (a) and (b) identified above within the meaning of § 102 and § 103 for the reasons set  
9 forth in the last reply.

10 (Remarks, pg. 6, 7)

11  
12 *The examiner respectfully responds:*

13 First, the examiner respectfully notes that applicant's remarks comprise only  
14 allegation and lack any supporting evidence or rationale as the basis for the applicant's  
15 conclusions. For this reason, at least, the examiner finds the applicant's remarks to be  
16 unpersuasive.

17 Second, the examiner respectfully notes that applicant's remarks allude to  
18 previously stated remarks of the applicant, of which have been addressed and shown to  
19 be unpersuasive according to record. Thus, for this reason, at least, the examiner again  
20 finds the applicant's remarks to be unpersuasive.

21 Third, the examiner respectfully notes that the applicant's statement, that the  
22 prior art fails to disclose a supposed "claimed permission-request sending feature" is left

unexplained and therefore is ambiguous. As the applicant appears unwilling to elaborate how a supposed "claimed permission-request sending feature" is lacking from the prior art, the examiner, at best, can only presume, in light of the actual claim recitations, that the applicant is somehow alleging that the prior art fails to teach the recited "*copy permission request*" (e.g. see claim 1, line 17). In this regard, the examiner respectfully notes that the prior art clearly discloses a "*copy permission request*" (e.g. Nozaki, par. 21, 103). Thus, the examiner respectfully finds the applicant's allegation to be unpersuasive and notes that the applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Finally, the examiner respectfully notes that applicant's allegations that the prior art lacks "*the server changing the count information or keeping track of copy count information or the PC sending the count information to the server each time the already downloaded music contents is copied to an external apparatus or recording medium*" to be unpersuasive. Again, it is noted, that as the applicant appears unwilling to elaborate as to how any supposed claim recitations are lacking from the prior art. In fact, it is respectfully noted that the applicant broad remarks fail even to specifically point out any actual claim recitation[s] that the applicant believes to be lacking within the prior art. Thus, the examiner respectfully finds the applicant's allegation to be unpersuasive and notes that the applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without

specifically pointing out how the language of the claims patentably distinguishes them from the references.

*Applicant argues essentially that:*

Third, applicant submits that Nozaki further would not have taught the following claimed features:

(c) storing together with the contents, user information for the user, including user ID information representing a plurality of information processing terminals belonging to the user; ...

(Remarks, pg. 7)

*The examiner respectfully responds:*

The examiner respectfully disagrees with the applicant. It is noted that the prior art clearly discloses the limiting feature of a server apparatus comprising storage [i.e. "server storing device"] (e.g. Nozaki, fig. 2:1; fig. 3). The examiner respectfully reminds the applicant that an apparatus is distinguished by structure (e.g. "storage") and not by intended use of the apparatus (e.g. "for storing numerous contents ... etc.). As the prior art clearly discloses a server comprising storage, the examiner notes that the prior art fully anticipates the claim limitations. Therefore, while the examiner points out that even while the prior art clearly discloses the intended use of the claimed storage structure (i.e. storage for storing information) and the nominal characterization of the significance of such stored information (i.e. "representing a plurality of information processing

terminals belonging to the user”), the examiner finds the applicant’s argument to be unpersuasive, at least, for the reason that the claimed limitation fail to distinguish from the prior art apparatus of a server further comprising the structure of storage.

*Applicant argues essentially that:*

Third, applicant submits that Nozaki further would not have taught the following claimed features:

...

(d) contents supplying server apparatus that supplies contents to each of the information processing terminals associated with the user.

(Remarks, pg. 7)

*The examiner respectfully responds:*

The examiner respectfully disagrees with the applicant. It is noted that the prior art clearly discloses that a user possesses a plurality of “information processing terminals”, wherein the “information processing terminals” [e.g. fig. 2: 2a, 2b] are each connected to “a communication network” and may be used by the user to download “contents” from a “contents supplying server apparatus” (e.g. Nozaki, fig. 2:2a, 2b, 3, 5, 6; par. 13,14, 40, 48).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFERY WILLIAMS whose telephone number is (571)272-7965. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffery Williams/  
Examiner, Art Unit 2437

/Emmanuel L. Moise/  
Supervisory Patent Examiner, Art Unit 2437